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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,719	11/19/2003	Randall J. Huebner	ACM 353	6328

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EXAMINER
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RAMANA, ANURADHA

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/716,719

Applicant(s)

HUEBNER ET AL.

Examiner

Anu Ramana

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 40-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-15, 17-21, 24, 40-46 and 51-53 is/are rejected.
- 7) ☒ Claim(s) 8-11, 16, 22, 23 and 47-50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/12/05:10/24/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 4-7, 12-14, 17-21, 24, 40-41, 43-46 and 51-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/717,399 ('399 herein) in view of Pierer et al. (US 6,340,362).

Claim 4 ('399 herein) discloses all elements of the claimed invention except for a pivotal joint by which the angular disposition of the first and second plate members is adjustable by movement of the plate members about two or more nonparallel or orthogonal axes.

Pierer et al. teach a bone plate for bone fixation including: first and second plate members (26, 24) the first plate member being T-shaped; the plate members having a convex upperside 28 and a concave underside 30; and a joint 54 connecting the plate members such that the angular disposition of the plates can be adjusted by pivotal movement of the first plate member in two or more non-parallel axes (Figures 2 and 4, col. 5, lines 26-67 and col. 6, lines 1-48).

Accordingly it would have been obvious to one of ordinary skill in the art to substitute a joint as, for example, taught by the Pierer et al. reference for the adjustable

joint of Claim 4 ('399) device wherein so doing would amount to mere substitution of one functionally equivalent structure for another within the same art and the selection of any of these structures would work equally well in the claimed device.

Claims 3 and 42 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/717,399 ('399 herein) and Pierer et al. (US 6,340,362) in view of Talos et al. (US 5,709,686).

The combination of claim 4 ('399) and Pierer et al. discloses all elements of the claimed invention except for threaded openings.

Talos et al. teach threaded holes in a bone plate to receive a screw with a threaded head (col. 1, lines 29-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided threaded openings in the plate of the combination of claim 4 ('399) and Pierer et al., as taught by Talos et al., so that the screws are vertically and rigidly engaged with the plate.

Claim 15 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/717,399 ('399 herein) and Pierer et al. (US 6,340,362) further in view of Esser (US 6,096,040).

The combination of claim 4 ('399) and Pierer et al. discloses all elements of the claimed invention except for the plate members being contoured to fit onto the volar surface of a radius bone.

Esser teaches contouring the underside of a bone plate to conform to the curvature of a distal radius (Fig. 22 and col. 12, lines 30-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have contoured the plate of the combination of claim 4 ('399) and Pierer et al., as taught by Esser so that the plate members are contoured to fit onto the volar surface of a radius bone.

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4, 6-7, 13-14, 18-20, 40-41, 43 and 45-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Pierer et al. (US 6,340,362).

Pierer et al. disclose a bone plate for bone fixation including: first and second plate members (26, 24) the first plate member being T-shaped; the plate members having a convex upperside 28 and a concave underside 30; and a joint 54 connecting the plate members such that the angular disposition of the plates can be adjusted by pivotal movement of the first plate member in two or more non-parallel axes (Figures 2 and 4, col. 5, lines 26-67 and col. 6, lines 1-48).

Regarding claim 13, the limitations, “generally complementary to a distal surface of the radius bone, such that the at least one plate member fits onto the radius bone,” is directed to the plate having the capability of being placed on the radius bone and is not a positive limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3733

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierer et al. (US 6,340,362) in view of Talos et al. (US 5,709,686).

Pierer et al. disclose all elements of the claimed invention except for threaded openings.

Talos et al. teach threaded holes in a bone plate to receive a screw with a threaded head for vertical and rigid engagement (col. 1, lines 29-45).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided threaded holes in the Pierer et al. bone plate, as taught by Talos et al., so that the screw is vertically and rigidly engaged with the plate.

Claims 5, 21, 44, 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierer et al. (US 6,340,362).

Pierre et al. disclose all elements of the claimed invention except: (1) for bone plate 20 having a T-shape; and (2) the second plate member flaring away from the first plate member.

It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the bone plate members 24 and 26 such that the bone plate 20 would have an T-shape, since applicant has not disclosed that this solves any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a plating system for treatment of a supracondylar fracture (see Fig. 9 of Dall et al. (US 5,665,089)). In re Dailey and Eilers, 149 USPQ 47 (1966).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierer et al. (US 6,340,362) further in view of Esser (US 6,096,040).

Pierer et al. disclose that depending on the anatomy the two plate parts 24, 26 could be formed with their upper and lower sides having different shapes (col. 5, lines 33-35).

Pierer et al. discloses all elements of the claimed invention except for the plate members being contoured to fit onto the volar surface of a radius bone.

Esser teaches contouring the underside of a bone plate to conform to the curvature of a distal radius (Fig. 22 and col. 12, lines 30-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have contoured the Pierer et al. plate, as taught by Esser so that the plate members are contoured to fit onto the volar surface of a radius bone.

### ***Response to Arguments***

Applicant's arguments submitted under "REMARKS" in the response filed on October 6, 2005 with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable Subject Matter***

Claims 8-11, 16, 22-23 and 47-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3733

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR

*Anuadha Ramana*  
December 23, 2005

*Pedro Philogene*  
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PRIMARY EXAMINER